

REMARKS

All of the claims 1 – 14 are once more rejected on entirely new grounds. All prior rejections are withdrawn. There are now new art rejections under Section 103 and new rejections under Section 112. Applicants request reconsideration of the rejections in view of the following argument. The new rejections presented under Section 112 are first addressed and then applicants address the art rejections.

REJECTIONS UNDER SECTION 112

The claims are all newly rejected on the basis of omitting essential steps. This rejection is not understood and appears to be incorrect as the Examiner has argued that there are “missing” steps, but applicants’ are not aware of any missing steps. The rejection contends that missing steps relate to a payment figure being a service fee to be paid by the user to a provider, and that nowhere in the claims or drawings is there an indication as to how to send the payment figure to the provider. In support of this rejection the office action cites MPEP 2172.01. However, none of this is understood. Applicants request reconsideration because:

- (i) claims 1 – 13 are not directed to a method; and
- (ii) while claim 14 is directed to a method, this and all other claims are directed to “determining” a payment figure. None of the claims require sending the payment figure. Nothing which the rejection cites relates to what the claims require.

It is submitted that the Examiner’s citation of MPEP 2172.01 is misplaced because this section and the section MPEP 2164.08 (cited at 2172.01) relate to enablement. As expressly stated in MPEP 2164.08, the relevant focus of the examination inquiry is whether the claim is enabled. There is nothing in the recited claims that is subject to any question of enablement. If the Examiner continues to reject the claims on this basis the Examiner must identify subject matter within the claim which lacks support. Subject matter which is tangential to the invention (such as how the payment fee might be communicated to a provider) has no bearing on whether

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the expressly claimed subject matter satisfies the requirements of Section 112. The basis for the rejection is in error and removal of the rejection is therefore in order.

REJECTIONS UNDER SECTION 103

All of the claims 1-14 were rejected under Section 103 based on Papadopoulos '454 (U.S. 6,282,454) in view of Mori '392 (U.S. 5,103,392). The rejection is based on an interpretation of the Mori reference which is over reaching. The Examiner has conceded that the '454 reference does not teach a processor adapted to determine a payment figure. However, the Mori reference also lacks the referenced subject matter. Indeed, the office action does not even allege that Mori discloses the subject matter of claim 1: "a processor unit adapted to determine a payment figure from operations running in the process control system ..."

That is, the rejection only references that which is expressly disclosed in the Mori reference. The office action states at page 3 that a system according to Mori:

"allows proprietors to obtain information on the exact state of use of software by a specific user and charge appropriately for that use."

Applicants do not disagree with this characterization of the Mori reference, but ask the Examiner to acknowledge that **this is not what is claimed**. In fact, the system disclosed in the Mori reference does not at all disclose applicants' subject matter (see claim 1) of

"a processor unit adapted to determine a payment figure ..."

and it would be error to infer otherwise.

The Mori reference is concerned with providing history of use so that proprietors "can charge for the exact amount of use ..." (see col. 1, lines 15 – 18), but the reference does not disclose or suggest a system to "determine" a payment figure. Providing a history of use is not a disclosure or suggestion of providing a payment figure.

To support applicants' traversal of the rejection on the basis of this deficiency, reference is made to col. 3, lines 29-31 of Mori which state that "the proprietor can obtain information necessary for charging the user the exact amount of use of his program." So, at best, the cited passage implies that the proprietor is provided with information enabling the proprietor to calculate a payment figure. The passage does not suggest that the system of Mori would determine a payment figure.

See, also, col. 3, lines 63-68 which clarify what is meant at col. 3, lines 44-46 concerning "storing data of the charge payable by the user ..." That is, lines 65-68 clearly indicate that an account portion 53 is connected to an input/output portion 132 so that information of the charge payable by the user can be stored in the use history 131, e.g., a predetermined limit on the amount of cumulative charges of a user. In this regard it is important to note that the proprietors are **not** part of the system disclosed by Mori. Rather, as indicated at col. 4, lines 20-30, the proprietors "register their programs ... [and] obtain accounts of the use of their programs ...". The description at col. 3, lines 63-68 and the input/output lines of figure 2 may imply that it is possible for the proprietors to input information into the history storage 13 such as a predetermined limit on the amount of cumulative charges of a user. Given this explanation, there is no support for contending that the system of Mori would determine a payment figure. For similar or identical reasons, the rejection of claim 14 is also deficient.

Based on the foregoing it cannot be concluded that the system of Mori determines any payment figure. Rather, the system only provides information on history of use to the proprietors who are then enabled to charge appropriately for the use.

In summary, the art rejection has failed to address the express language of the claims and find the claimed subject matter in the prior art. To sustain a rejection under Section 103 it is necessary to find every claimed feature in the same detail as recited in the claims. The deficiencies present in Mori reference preclude such a finding and the rejection must therefore be withdrawn.

Conclusion

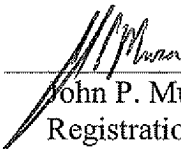
For all of the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are not properly grounded and it is incumbent upon the Examiner to either remove the rejections and allow the application, or to present a new, non-final office action which presents a clear and proper basis for rejecting the claims and which accords the applicants an opportunity to amend the claims if need be.

MPEP §707.02 requires the supervisory patent examiner to impress their upon the examiner the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them. That section also requires the supervisory patent examiner to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

The Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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